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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert H. Dahla

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ARTHROCARE CORPORATION

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EXAMINER

WITCZAK, CATHERINE

ART UNIT

PAPER NUMBER

3767

NOTIFICATION DATE

DELIVERY MODE

02/21/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel_prop@arthrocare.com

Office Action Summary	Application No. 10/799,908	Applicant(s) DAHLA ET AL.	
	Examiner CATHERINE N. WITCZAK	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/14/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggers et al (US 5,697,882) or (US 5,871,469) or (US 5,683,366).

The Eggers reference discloses an electrosurgical probe and method for treating a target tissue at a surgical site in figure 20 comprising a shaft and an electrode assembly disposed on the shaft, wherein the electrode assembly includes an electrically insulating electrode support and at least one active electrode terminal arranged on the electrode support, each of the at least one active electrode terminal having an electrode lumen therethrough, wherein the electrode lumen is adapted for removing unwanted materials from the surgical site; and the at least one active electrode terminal comprises an end having an open electrode port in communication with the electrode lumen; and the at least one active electrode terminal comprises a body having a suction opening formed therein, the suction opening in communication with the electrode lumen, see attached figure below which comes from figure 20 and see col. 8 lines 8-53, col. 11 line 39 - col. 12 line 52, and col. 24 lines 8-31.

With respect to claims 2-14 & 17-19, for all 3 references see figure 20.

With respect to claims 15-16, see col. 11 line 39 - col. 12 line 52.

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With respect to claim 20, see col. 3 line 47 - col. 4 line 47.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

2. Claims 1, 3-11, 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Stasz (US 4,936,281).

The Stasz reference discloses an electrosurgical probe and method for treating a target tissue at a surgical site in figure 2 comprising a shaft and an electrode assembly disposed on the shaft wherein the electrode assembly includes an electrically insulating electrode support 34 and at least one active electrode terminal 38 having a lumen therethrough and wherein the electrode lumen is adapted for removing unwanted materials from the surgical site, and the at least one active electrode terminal comprises an end having an open electrode port in communication with the electrode lumen; and the at least one active electrode terminal comprises a body having a suction opening formed therein, the suction opening in communication with the electrode lumen; also see col. 3 line 17 -col. 4 line 15, and col. 6 lines 31-45.

Response to Arguments

Applicant's arguments filed 12/14/2007 have been fully considered but they are not persuasive. Applicant argues that claim 1 describes two distinct openings in the electrode terminal – an open electrode port and a suction opening; and that neither Eggers nor Stasz disclose separate port and suction openings. Examiner disagrees. Both Stasz and Eggers disclose a hollow cylindrical electrode structures.

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As in any cylindrical structure, the cylindrical electrode structures of Eggers and Stasz have two ends, which are open (providing a tube-like structure). In both the Eggers and Stasz references, both ends are open, and thus disclose devices having both an open electrode port (one open end of the cylinder) and a suction opening (the second open end of the cylinder), the two openings being distinct from each other and connected by an electrode lumen which runs between to the ends.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE N. WITCZAK whose telephone number is (571)272-7179. The examiner can normally be reached on Monday through Friday, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine N Witzak/

Examiner, Art Unit 3767

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767